

REMARKS

Applicants have received and carefully reviewed the Final Office Action mailed May 8, 2009, in which claims 10-13, 15-18 and 23-31 were under review and have been rejected. Applicants respectfully traverse all adverse assertions, objections, and rejections presented in the Office Action. With this amendment, claims 28-31 are amended to correct a typographical error and claim 17 has been canceled. Replacement Figure 6 is provided herein to comply with the Examiner's requirement for correction. The specification has been amended to include a description for Figure 6 and to correct reference numerals in view of replacement Figure 6. No new matter has been added. Applicants respectfully request entrance and favorable consideration of the above amendments and the following remarks.

Election/Restriction

Claim 31 is withdrawn from consideration.

Drawings

The drawings were objected to under 37 CFR 1.83(a) as not showing every feature of the claimed invention. Specifically, the "a sheath extending about the catheter and covering said stent" of claim 17 and "a second adapter having an outer diameter substantially equal to the inner diameter of the catheter" of claim 23 were noted.

Applicants note that 35 U.S.C. 113 states: "The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented." Applicants submit that a drawing is not required to understand the subject matter of claim 17, as the specification states at page 9, lines 7-8, that the sheath may be included "as is known in the art". However, in order to advance prosecution, claim 17 is hereby cancelled without prejudice, rendering the objection moot.

With respect to the second adapter of claim 23, this is described on page 9 of the specification as being part of a catheter system in the form of a kit, where "a catheter system is further provided with a plurality of adapters 30, each being selectively positionable and insertable within catheter lumen 21 of catheter 20. Each of these plurality of adapters 30 includes an outer diameter 34 substantially equal to inner diameter 24 of catheter 20.

Moreover, each of these plurality of adapters 30 includes an inner lumen 31 which defines a mutually distinct, different size inner diameter 33 for each respective adapter 30.” As such, the second adapter is selected on occasion instead of the first adapter. In order to comply with the Examiner’s requirement, Figure 6 (and the corresponding portion of the specification) has been amended to reference three distinct adapters.

Applicants now submit that the drawings are in compliance with 37 CFR 1.83(a).

Specification

The specification was objected to as having no description of Figure 6 in the BRIEF DESCRIPTION OF THE DRAWINGS.

A description of Figure 6 has been included with this amendment. As this is the language found in the now-issued as US 6,692,482 parent application, it is believed that no new matter has been introduced.

Claims 17 and 23-30 were objected to as not showing a sheath or a second adapter. It is believed that these objections have been resolved by amendment as described above.

Claim Rejections—35 USC 112

Claims 17 and 23-30 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Applicants must respectfully traverse the rejection.

Regarding claim 17, the specification recites, for example, “Catheter system 11 may further include a sheath 19 extending externally thereabout in a tight manner, as is known in the art.” However, without conceding the correctness of the rejection, claim 17 has been canceled as discussed above, rendering the rejection moot.

Regarding claims 23-30, Applicants submit that page 9 of the specification offers the required written description, and that the rejection of a claim limitation that is “not consistency with the Figs. 1-5” under 35 USC 112, first paragraph, is therefore improper. Regardless, the specification at page 9 recites, for example, “Such a catheter system is further provided with a plurality of adapters 30, each being selectively positionable and insertable within catheter lumen 21 of catheter 20. Each of these plurality of adapters 30 includes an

outer diameter 34 substantially equal to inner diameter 24 of catheter 20. Moreover, each of these plurality of adapters 30 includes an inner lumen 31 which defines a mutually distinct, different size inner diameter 33 for each respective adapter 30.”

Applicants therefore submit that the claimed subject matter was described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed and consequently request withdrawal of this rejection.

Claim Rejections—35 USC 103

Claims 10-12 and 23-30 were rejected under 35 USC 102(b) as anticipated by, or in the alternative, under 35 USC 103(a) as obvious over Stevens (U.S. Patent No. 4,798,586). Applicants respectfully traverse the rejection.

Stevens pertains to a method and apparatus for aiding dilation catheterization that involves the insertion of an atherectomy device through a lumen of a balloon catheter. Stevens does not appear to teach or suggest all the elements of claim 10, nor are the elements obvious over the atherectomy system of Stevens.

For example, Stevens does not appear to disclose an adapter as claimed. The Office Action claims that elements 10b and 60 comprise the adapter. However, it is noted that elements 10 and 10b, are described at column 3, lines 52-55 as defining an air passageway 40 leading to balloon 11, where air passageway 40 is used to inflate the balloon. Therefore, it appears that intermediate catheter 10b cannot have an external diameter substantially equal to the internal diameter of catheter 10 without closing off this passageway and rendering the device inoperative. Moreover, adapter 60 is bounded on both sides in Figure 7 by element 64 and it is clear from that figure that no external diameter of adapter 60 or alternate adapter 90 is substantially equal to an internal diameter of catheter 10. The smallest part of adapter 60 fits in hub 46 and even that part is substantially larger than the inner diameter of catheter 10.

Moreover, element 64 is the sleeve of the atherectomy device 30 and is not described as having a smaller diameter than guidewire 20. Nor, after all, is there any need for sleeve 64 to have a smaller diameter than guidewire 20; both occupy the same lumen. Applicants can think of no reason why the one would have a smaller diameter than the other.

For at least these reasons, Applicants submit that claim 10 is allowable over Stevens.

With regard to claim 11, which recites “wherein said adapter is removably slidable within said lumen of said catheter,” Applicants submit these additional reasons. Adapter 60 is not removably slidable within the lumen of catheter 10. Element 10b is likely the inner tubular member of catheter 10 and is therefore not slideable within the catheter.

With regard to claim 12, which recites “wherein said adapter extends beyond the length of said catheter,” Applicants note that Stevens does not disclose an adapter that extends beyond the length of said catheter, as discussed above.

Claim 23 recites “a first adapter having an outer diameter substantially equal to the inner diameter of the catheter” and claim 27 recites “providing a plurality of adapters, wherein each of the plurality of adapters has an outer diameter substantially equal to the inner diameter of the catheter.” These claims are therefore allowable over Stevens for at least the reasons discussed above. As claims 24-26 and 28-30 depend from claims 23 and 27 respectively, and contain additional elements, Applicants submit that these claims are also in condition for allowance.

Claim 13 was rejected under 35 USC 103(a) as unpatentable over Stevens in view of Donadio III et al., (U.S. Patent No. 5,741,429) and claims 15-17 were rejected under 35 USC 103(a) as unpatentable over Stevens in view of Leoffler (U.S. Patent No. 5,891,154). Applicants respectfully traverse the rejection.

For at least the reason that these claims depend from claim 10, which Applicants submit is allowable, and contain additional elements, Applicants submit that these claims are in condition for allowance as well.

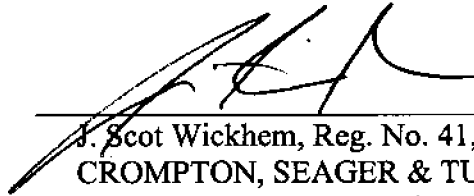
Conclusion

Further examination and withdrawal of the rejections are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,
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By their attorney,

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